



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,846	02/06/2002	Bryan G. Hughes	400064.401	3733
500	7590	03/25/2004	EXAMINER	
SEED INTELLECTUAL PROPERTY LAW GROUP PLLC 701 FIFTH AVE SUITE 6300 SEATTLE, WA 98104-7092			NGUYEN, KIM T	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/072,846

Applicant(s)

HUGHES, BRYAN G.

Examiner

Kim Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-134 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-134 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/26/02 &amp; 6/13/03</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Objections*

1. Claim 48-49, 64-65, 93, 104 are objected to because of the following informalities:
  - a) In claim 48, lines 4-5 and 6; claim 49, lines 4-5; claim 64, lines 5-6; and claim 65, line 5, the claimed limitation "one or more" should be corrected to "the one or more".
  - b) In claim 93, line 6, and claim 104, line 6, the claimed limitation "at least at least" should be corrected to "at least".

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-134 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
  - a) Claims 1, 19, 37, 53, 69, 78, 87, 98, 109 and 122 are a single means claim or a single step claim which do not comply with the enablement requirement. *In re Hyatt*, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983).

- b) The remaining claims are rejected as being dependent on the rejected base claim.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-134 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muniz (US 2002/0037766) in view of Leason et al (US 6,251,017).

a. As per claim 1, 12-14, and 17, Muniz discloses a method comprising populating a lottery bet slip (paragraphs 0136 and 0134). Muniz does not disclose using commercial icon. However, Leason discloses using commercial icon to fill a game card (Fig. 8; col. 9, lines 22-24). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the commercial icon of Leason to fill the lottery bet slip of Muniz in order to promote commercial products.

b. As per claim 2-6, using trademark, service mark, commercial name, geographic mark, etc. as a commercial icon would have been well known to a person of ordinary skill in the art at the time the invention was made.

c. As per claim 7-11, Leason discloses presenting a commercial icon, accepting input selection of the icon, inserting and displaying the icon into the game card (Fig. 8; col. 9, lines 22-28).

- d. As per claim 15, Muniz discloses accepting input which triggers the betting 366 (Fig. 2).
- e. As per claim 16, refer to discussion in claim 11 above.
- f. As per claim 18, Muniz discloses transmitting the lottery bet slip via a communication link (paragraphs 0051-0052).
- g. As per claim 19-36, refer to discussion in claims 1-18 above.
- h. As per claim 37, refer to discussion in claim 1 above. Further, Muniz discloses comparing the bet slip against a winning criteria (paragraph 0059).
- i. As per claim 38-43, refer to discussion in claims 2-6 and 18 above.
- j. As per claim 44-45, Muniz discloses comparing the content of the bet slip with a winning criteria (paragraphs 0059-0061). Further, selecting a master bet slip for comparing a position of the lottery bet slip with the selected master bet slip as desired by a designer requires only routine skill in the art.
- k. As per claim 46 and 50-51, logging a commercial icon, transmitting a bet confirmation would have been well known to a person of ordinary skill in the art at the time the invention was made.
- l. As per claim 47-49, Muniz discloses transmitting a winning notification (paragraph 0152).
- m. As per claim 52, refer to discussion in claim 6 above.
- n. As per claim 53-134, refer to discussion in claims 37, 43-51, 1-11, and 14-17 above.

*Cited Reference*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

*Slattery* (US 2003/0153381) discloses using trademark and logo in the game (paragraph 0331).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (703) 308-7915. The examiner can normally be reached on Monday-Thursday from 8:30AM to 5:00PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg, can be reached on (703) 308-1327. The central official fax number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.



Kim Nguyen  
Primary Examiner  
Art Unit 3713

kn

Date: March 18, 2004